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| MEDLEY, M |

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/040,911
Filing Date: 3/18/98
Appellant(s): Michael John Gundy

Paul D. Greeley
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed January 18, 2000.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 1-17.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is deficient because paragraphs 2, 3 and 5-9 are line 2 for "superior" and "engine" in paragraph 1 and paragraphs 2-3 and 509 under the title Summary of the Invention do not correspond to the Summary of the Invention found on page 7 of the instant application.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

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The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

| | | |
|-------------|-----------------------------|---------|
| 5,833,721 | Hart | 11-1998 |
| WO 94/20593 | Mobil Oil Corp. | 9-1994 |
| WO 96/23855 | Exxon Chemical Patents Inc. | 8-1996 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-17 are rejected under 35 U.S.C. 103a. This rejection is set forth in prior Office action, Paper No. 5 mailed on December 18, 1998.

(11) Response to Argument

Applicant's arguments filed with Appeal Brief on January 18, 2000 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., in Argument 1 with respect to WO 94/20593 does not tech improve injector cleanliness purposes) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

A review of WO 94/20593 at page 5 last paragraph and page 6 first paragraph indicates that the detergent additive maintains cleanliness in the injectors and other close-tolerant

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components especially those close to the higher temperature areas of the engine, preference given to poly (alkenyl succinimide). The preferred detergent is a polybutenyl (bis (succinimide) but is not limited to the preferred bis-succinimide). The polybutenyl has a molecular weight about 1200 which overlaps Appellant's claimed number average molecular weight (Mn) range from 850 to 1150. Obviousness may still exist if the range are close enough that one would not expect a different in properties, note Titanium Metals Corp. v. Banner 227 USPQ 773. (Fed. Cir. 1985). It is further noted that WO 94/20593 in prepared its preferred detergent polybutenyl bis(succinimide) from polyisobutenyl succinic anhydride and tetraethylene pentamine in a ratio of 2:1, wherein it is obvious that mono(succinimide) is prepared in a ratio of 1:1 which clearly overlaps Appellant's claimed range of A:B of 4:3 to 1:10 and 6:5 to 1:2.

Prior 96/2355 and Hart et al at col 5 line 42 to col. 6 line 50 the first paragraph of page 6 teach that the preferred acrylate amino compound is made by reacting an acrylating agent, eg. substituted succinic acid or anhydride with a nitrogen compound which clearly render obvious Appellants' molar ratio when it is a 1:1 ratio. Appellant is reminded that the reference is not limited to its teachings Examples. Thus prior art WO 96/23855 and Hart et al detergent additives render the claimed detergent additives obvious.

The Examiner have received and reconsidered Appellants Case laws and arguments made of in the Appeal Brief. It is the Examiner's position that the above rebuttals refute Argument 2 set forth in the Appeal Brief because the prior art have met every limitation of the claims by providing basis of obviousness rejection under 35 U.S.C. 103(a).

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With respect to Argument 3 set forth on page 10 of the Appeal Brief, the Examiner have reviewed and reconsidered the Experimental data of relied on as showings of the results presented therein to rebut the prior art of record. The Examiner maintains the position stated in the final Office action paper No. 9 that Appellants have not drafted the claims in a manner to be within the scope argued and supported by the Experimental data of record in the instant Application because the drafted claims do not exclude the teachings of the relied on prior art (5,833,721) used in the art rejection of record. It is noted that arguments unsupported by factual evidence do not take the place of objective evidence of unobviousness.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Margaret B. Medley
April 27, 2000

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